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IN THE
Supreme Court of the United States
OCTOBER TERM, 1964

No. 932

EDWARD J. BRENNER, Commissioner of Patents,
Petitioner,

v.

ANDREW JOHN MANSON

On Petition for a Writ of Certiorari to the
United States Court of Customs and Patent Appeals

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 13)* is reported at 333 F. 2d 234, 142 USPQ 35.

* Pet. App.—Designates the appendix printed in the Petition.

THE JURISDICTIONAL MATTER

The basis for jurisdiction is as alleged in the Petition.

The jurisdiction of this Court to grant a writ of certiorari to the United States Court of Customs and Patent Appeals *upon petition of the Commissioner of Patents* is denied.

STATUTES AND PATENT OFFICE RULES OF PRACTICE INVOLVED

The provisions of Article I, Section 8, clause 8 of the Constitution of the United States, 28 U.S.C. 1256, 35 U.S.C. 101, and 35 U.S.C. 112 are set forth in the petition at page 3.

The following Statutes and Patent Office Rules of Practice which are also involved are set forth in the appendix to this brief:

35 U.S.C. 6	At Resp. App. 21
35 U.S.C. 103	At Resp. App. 21
35 U.S.C. 134	At Resp. App. 21
35 U.S.C. 135	At Resp. App. 21
35 U.S.C. 141	At Resp. App. 22
35 U.S.C. 144	At Resp. App. 22

Rule 204(b) - Prior to January 1, 1965
At Resp. App. 22

Rule 204(b) and (c) - After January 1, 1965
At Resp. App. 23

Rule 131 At Resp. App. 24

THE QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review, on certiorari, a decision by the United States Court of Customs and Patent Appeals *favorable* to an applicant-appellant in a case arising from the Board of Appeals of the United States Patent Office.

2. Whether, to satisfy the requirements of Patent Office Rule 204(b) (before it was amended) to prove a *prima facie* case of priority of invention relative to the filing date of a patentee, an applicant for a patent on a new process for making an old compound must establish a utility for such previously known compound preparatory to having an interference declared between his application and the prior patent.

3. Whether a chemical process is a "useful process", within the meaning of 35 U.S.C. 101, if it produces a previously *known* chemical compound which had been described in an earlier scientific journal as a member of a group of compounds of great current scientific interest.

4. Whether, in view of 35 U.S.C. 135, a Primary Examiner of the United States Patent Office has jurisdiction to decide any question in any way determinative of priority of invention as between parties claiming the same patentable subject matter.

STATEMENT OF THE CASE

The decision below determined what an applicant for a patent must establish to satisfy Patent Office Rule 204(b), preliminary to the declaration of an interference¹ between his application and a prior patent.

Respondent's patent application (R²-3-9) claims a new process for making an old chemical compound, 2-alpha, 17-alpha-dimethylandrostan-17-beta-ol-3-one.³

¹ An "interference" is a proceeding instituted pursuant to 35 U.S.C. 135 for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention.

² "R" refers to the transcript of record printed for use by the United States Court of Customs and Patent Appeals.

³ For simplicity this compound will henceforth in this brief be referred to as the "2-alpha compound".

This 2-alpha compound became known when it was described in a journal article by Ringold et al. published in J. Org. Chem. November, 1956, Vol. 21, pages 1333-1335 (R-75-79). That article also described a process for making the 2-alpha compound and related compounds and stated the compounds were of great scientific interest.

Ringold et al. United States Patent 2 908 693 (R-73) [the patent with which respondent is seeking interference] issued in 1959, claiming a new and different process for making the journal article compounds.

Respondent thereafter timely filed his patent application, claiming the same new process as the Ringold et al. patent and asked the Patent Office to declare an interference with the patent. Respondent also filed concurrently a Rule 204(b) affidavit.⁴ No objection was made to the contents of Respondent's patent application, but only to the Rule 204(b) affidavit.

Respondent filed affidavits (R-13, 14, 48, 61 and 62) which cumulatively established that, prior to the December 17, 1956 priority date of the Ringold et al. patent, respondent (a) made the invention described in his patent application; (b) performed all the steps of his claimed process as documented by copies of his notebook records; (c) was an expert research chemist experienced in synthesizing steroid compounds in research projects designed to produce new medicinal agents in the field of endocrinology; (d) had read the Ringold et al. published journal article; and, (e) believed the utility of the claimed process was obvious to him in that it would produce the 2-alpha compound, the utility of which, as a hormone analog described in

⁴ See Resp. App. 22 for the text of this Rule stating what the affidavit is to contain.

the journal article by Ringold et al., was also obvious to him.

The Examiner regarded the Rule 204(b) affidavits as insufficient to establish a prima facie case of invention by Respondent prior to the filing date of the patentee, because the affidavits: (1) failed to disclose any utility for the 2-alpha compound made by the claimed process; and, (2) failed to show the 2-alpha compound was known to have any utility prior to the effective date of the Ringold et al. patent. Because the Primary Examiner refused to declare an interference between Respondent Manson's application and the Ringold et al. patent, Manson's claims were rejected on the Ringold et al. patent. Manson then appealed to the Patent Office Board of Appeals (R-47) [under 35 U.S.C. 134].

The Board of Appeals affirmed the Examiner for three reasons, saying: (1) *In re Dickinson and Zenitz*, 299 F. 2d 954, 49 CCPA 951, 133 USPQ 39, which held an allegation in a Rule 204 (b) affidavit that the particular named utility of the claimed invention was obvious to the inventor, may constitute completion of the prima facie case of priority of invention, did not apply (R-68); (2) the fact the compounds produced by the claimed process may be hormones, and closely related to another hormone shown by the Ringold et al. publication to have utility as a tumor inhibitor, cannot be considered a showing of utility (R-68); and, (3) a process is not prima facie useful merely because the product is disclosed in the literature, unless the *product* was known to be useful (R-69).

Respondent appealed to the United States Court of Customs and Patent Appeals (R-69) [under 35 U.S.C.

141] which reversed the decision of the Board of Appeals, one judge dissenting. The court below held (Pet. App. 13): (1) since Manson's process works and is not alleged to be detrimental to the public interest, it is useful; (2) Rule 204(b) is satisfied by an affidavit showing operability of the claimed process to produce a known product and there is no additional requirement under 35 U.S.C. 101 that a "use" for such known product be disclosed; and, (3) *In re Dickinson and Zenitz*, 299 F. 2d 954, 49 CCPA 951, 133 USPQ 39, which sets forth the Commissioner's duties and responsibilities is determinative of the instant case.

The Commissioner was directed to initiate the interference between the Manson application and the Ringold et al. patent.

A. ARGUMENT—ON JURISDICTION

1. BECAUSE REVIEW IS SOUGHT BY THE COMMISSIONER OF PATENTS, THIS COURT LACKS JURISDICTION

There is a serious jurisdictional question involved, which the Court ought resolve. Respondent's version of that question differs from that of Petitioner.

Respondent agrees with the broad proposition this Court has jurisdiction to review on certiorari a decision by the United States Court of Customs and Patent Appeals in a case on appeal from the Board of Appeals of the United States Patent Office. [The reasoning and background are found in Stern and Gressman "Supreme Court Practice" 3rd ed., 1963, pages 56-60.]

However, Respondent submits this jurisdiction is limited to cases where the review is sought by the patent applicant, and does not extend to cases where the party seeking review is the Commissioner of Patents,

as the instant case. The right of only one of two parties to seek review is not unusual in *ex parte* patent cases.

Patent appeal procedure begins with 35 U.S.C. 134 which provides:

"An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals . . ."

Thereafter, the applicable appeal statute is 35 U.S.C. 141, which provides:

"An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals . . ."

Thus, statutory authority for appeal is limited to an applicant for patent.

The Congressional intent to limit review of decisions of the Court of Customs and Patent Appeals in *ex parte* patent cases to instances where review is sought by the patent applicant can be seen by comparing the language of the statutes granting jurisdiction to this Court to review cases from various other courts and from the Court of Customs and Patent Appeals and noting the differences in language.

28 U.S.C. 1254 dealing with review of cases from the courts of appeal provides:

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
(1) By writ of certiorari granted upon a petition of *any party* to any civil or criminal case . . ."
(Emphasis ours)

28 U.S.C. 1255 dealing with review of cases in the Court of Claims provides:

“Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods:

(4) By writ of certiorari granted on petition of the United States *or* the claimant; . . .” (Emphasis ours)

28 U.S.C. 1256 dealing with review of cases in the Court of Customs and Patent Appeals provides:

“Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.”

In the latter statute, it is not spelled out who can petition for the writ, contrary to the preceding instances which specify that *any party* can petition.

This Court had occasion to consider the relationship between the Commissioner of Patents and the penultimate predecessor of the present United States Court of Customs and Patent Appeals in *Butterworth v. Hoe*, 112 U.S. 50, 59 and noted

“If dissatisfied with his [the Commissioner of Patents] decision, the party . . . , may appeal to the Supreme Court of the District of Columbia. Rev. Stat. Sec. 4911. To that appeal the Commissioner is a formal party, A certificate of its [the court’s] proceedings and decision is to be returned to the Commissioner and entered of record in the Patent Office, and shall govern—so the statute says—the further proceedings in the case,
“It is evident that the appeal thus given to the Supreme Court of the District of Columbia from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statu-

tory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. *Its adjudication, . . . is, . . . conclusive upon the Patent Office itself, for as the statute declares, Rev. Stat. Sec. 4914, it 'shall govern the further proceedings in the case.'* *The Commissioner cannot question it.* He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the Secretary as well as the Commissioner, . . ." (Emphasis ours.)

Statutory language substantially identical to that above considered is in effect today as 35 U.S.C. 141 and 35 U.S.C. 144. The latter statute states:

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal * * * *. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

The Commissioner is bound to accept the decision of the Court of Customs and Patent Appeals and has no statutory authority to seek review here.

B. ARGUMENT—ON THE "MERITS"**1. THERE IS NO CONFLICT OF DECISION BECAUSE DIFFERENT STATUTORY PROVISIONS ARE INVOLVED IN THE RESPECTIVE DECISIONS**

Petitioner incorrectly asserts (Pet. 5)

"The decision below, holding that a patent may be obtained on a process for the production of a useless product—a holding which is in direct conflict with the decision of the Court of Appeals for the District of Columbia Circuit in *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, certiorari denied, 355 U.S. 955 . . ."

A different statutory provision is involved in the instant case and in *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, wherefore completely different legal issues were presented in each case. Thus, the decisions being on different points of law, are not in conflict at all.

The *Petrocarbon* opinion stated, 247 F. 2d 800:

"This is a patent case, in which the Patent Office rejected an application on the ground it did not meet the requirement of 35 U.S.C. 112 (1952) . . ."

The opinion of the Court here below stated (App., p. 17):

"It seems clear from the present record that the Patent Office refused to accept appellant's affidavits on the philosophical basis that unless a compound is known to be useful, a process for making the compound is not useful under Section 101 and hence not patentable."

In *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800, the sole question was whether applicants' patent specification was fatally defective as a matter of law for failure

to meet the requirement of 35 U.S.C. 112 that it contain "... a written description of the invention, and of the manner and process of making and using it ...". The court did not say the invention was not useful, but only held the specification did not explain *how the invention was to be used*, as required by 35 U.S.C. 112.

In the instant Manson case there was no contention applicant's specification (application disclosure) did not meet the requirements of 35 U.S.C. 112. The Statute here involved is 35 U.S.C. 101, which contains the requirement the invention be a "useful process".

A 35 U.S.C. 112 rejection says in effect: Your invention may be otherwise patentable but your specification is defective. A 35 U.S.C. 101 rejection says in effect: Your specification may be fine, but your invention is not patentable because it is not useful.

The very real differences between the "useful" requirement of 35 U.S.C. 101 and the "how to use" requirement of 35 U.S.C. 112 are spelled out at length in *In re Nelson et al.*, 280 F. 2d 172, 47 CCPA 1031, 126 USPQ 242.

Cases involving different statutory provisions present no conflict on the same matter of law for this Court to resolve.

2. THERE IS NO IMPORTANT QUESTION OF LAW IN ISSUE

While Petitioner's second "Question Presented" reading:

"Whether a process which produces a useless product is patentable" (Pet. 2)

may be an important question of law, it is NOT a question in THIS case. The reasons it is hypothetical, and not a proper question here, are:

**(a) Patentability of the Already Patented Process
is Not in Issue**

The process involved in this case has been determined to be patentable by the Petitioner since the Petitioner issued a patent claiming the process, i.e., Ringold et al. Patent 2 908 693.

All that remains for decision is whether such patentable process was first invented by Ringold et al. or by Respondent.

**(b) Respondent's Process Does Not Produce a
"Useless" Product**

By Petitioner's use of the wording "useless product" in his statement of the Question Presented, he commits the error in logic known as "petitio principii" or "begging the question". Moreover, Petitioner's question is hypothetical because the process here involved does not produce a "useless" product.

The dissenting opinion (Pet. App. 22) made reference to a process which produces a "useless" product, but such reference is factually incorrect. The record shows the 2-alpha compound produced by the claimed process is useful. The record shows the 2-alpha compound has a high anabolic, androgenic ratio and is especially valuable where an anabolic or antiestrogenic effect together with a lesser androgenic effect is desired (R-73), and that researchers considered the compound to be desirable and worthwhile making since it is one of a group of compounds "of great interest due to the discovery that certain members of this series have been found to be massive inhibitors of the development of a transplantable rat mammary tumor" (R-76). Anything people want for a legitimate purpose, including research, is "useful". The case law on this point

is well established (Pet. App. 19, et seq.). The cases cited in the dissent below (Pet. App. 22) are concerned only with "inoperativeness", which is not here an issue.

(c) The Instant Case is Interlocutory in Nature

The instant case is interlocutory in that it did not finally determine Respondents' right to receive a patent.

The effect of the decision of the Court below is that the Commissioner of Patents was directed to institute an interference involving Respondent and a patentee.

The decision below does not hold appellant ought be granted a patent. It does not hold the patentee is not entitled to his patent.

The decision below is an appellate ruling on an interlocutory order in an *ex parte* proceeding of a Federal Agency. Legal rights and relationships to which liabilities or sanctions may accrue have not been established. The case does not warrant review by this Court. *Rochester Telephone Corp. v. United States*, 307 U.S. 125, 131; 59 S. Ct. 754; *Hayes v. Fischer*, 102 U.S. 121; *American Construction Co. v. Jacksonville, T. & K.W.R. Co.*, 148 U.S. 372, 385; 37 L. Ed. 486, 13 S. Ct. 495; *Baltimore Contractors v. Bodinger*, 348 U.S. 176, 75 S. Ct. 249.

**(d) The Court Would Likely Not Reach
the Question Posed by Petitioner**

The decision below was not concerned with the question stated by Petitioner, but with a completely different issue in which any utility question was only incidentally involved. As the opening paragraph of the majority opinion states:

"The single legal issue presented by this appeal is whether an applicant for a process on a new process for making a known compound must establish a utility for such compound, in order to satisfy the requirements of Rule 204(b) *preparatory to having an interference declared* between his application and a prior patent." (Pet. App. 13)

That single issue actually involved a number of sub-issues, ignored by petitioner, which effectively foreclose consideration of petitioner's proposed question. A short explanation will be helpful.

When respondent, Manson, first filed his Rule 204(b) affidavits, questions arose as to whether there was compliance with the rule. Rule 204(b) then provided

"... when required the applicant shall file an affidavit (of the nature specified in rule 131 setting forth facts which would *prima facie* entitle him to an award of priority relative to the filing date of the patentee."

The Primary Examiner stated the facts set forth in the affidavit did not make out a *prima facie* case of priority of invention. Later, additional related questions arose because of the intervening decision in *In re Dickinson and Zenitz*, 299 F. 2d 254, 49 CCPA 951, 133 USPQ 39, which held that, where a Rule 204(b) affidavit stated the utility of the invention was obvious, this was sufficient to complete the *prima facie* case, so the interference had to be declared—since otherwise the primary examiner actually would be determining priority, when the governing statute, 35 U.S.C. 135, requires that priority be determined by a Board of Patent Interferences. In a sense there was involved a "jurisdictional dispute" between two entities housed within the Patent Office itself.

Thus, even assuming *arguendo* respondent's invention actually is useless, within the Patent Office only the Board of Patent Interferences has statutory jurisdiction to determine this under the circumstances of this case; a determination which would not occur until the interference had been declared and until after testimony of the parties has been taken. [The instant case has not progressed to that point, and the interference has yet to be declared.]

Since the primary examiner, by statute, could not properly determine this question of utility in the present posture of the case, neither can this Court. The Court's right to decide this particular question can only derive from the primary examiner. In other words, before this Court can reach any utility issue, it must first determine that the court below was wrong in holding the applicable statute, 35 U.S.C. 135, did not allow the Commissioner (acting through his designee, the Examiner) to determine priority in the guise of a determination of what constitutes a *prima facie* case of priority relative to the filing date of the patentee. If that question is decided adverse to Respondent, the Court would then consider whether the Rule 204(b) affidavits filed presented a *prima facie* case of priority, under any possibly applicable interference precedent. If that question also is decided adverse to respondent, only then would the Court reach the question petitioner wants reviewed. The actual questions presented in this case are those formulated by respondents in this brief.

**3. RULE 204(b) HAS BEEN AMENDED IN A MANNER WHICH
WILL PREVENT THE ISSUE FROM ARISING IN THE
FUTURE**

The actual issue below primarily involved an interpretation of the requirements of Patent Rule 204(b). On January 1, 1965, Rule 204(b) as it read when this case was before the Patent Office and the court below, ceased to exist. It had been amended in such a way that the actual issue below can never again arise in any future case. See the appendix to this brief, pages 22 and 23, for the complete wording of the rule before and after its amendment. Previously Rule 204(b) contained the now deleted words

“ . . . and, when required, the applicant shall file an affidavit (of the nature specified in rule 131) setting forth facts which would prima facie entitle him to an award of priority relative to the filing date of the patentee.”

This language was why the Primary Examiner examined respondent's affidavits to determine whether he thought a prima facie case of priority existed. The amended rule no longer allows the Primary Examiner to determine this. Note that the newly added section, Rule 204(c), last sentence thereof, specifically limits what the Primary Examiner may consider to a mere determination of whether a date prior to the effective filing date of the patentee is alleged. In the future, all aspects of priority will be determined by the Board of Patent Interferences only. Because of the rule change the issue determined by the court below can never again arise, and is moot as a precedent for future cases.

4. THE QUESTIONS IN THIS CASE ARE UNRELATED TO THOSE INVOLVED IN OTHER CASES NOW BEFORE THE COURT

Petitioner says: (Pet. 11)

"An appropriate opportunity to resolve the question in the larger context of related patent problems is presented by other cases on the Court's calendar or pending on petitions for certiorari. See *Graham v. John Deere Co.*, No. 580, certiorari granted, Jan. 18, 1965; *Calmar, Inc. v. Cook Chemical Co.*, No. 778, petition pending; *Colgate-Palmolive Co. v. Cook Chemical Co.*, No. 810, petition pending; *United States v. Bert N. Adams*, No. 906, petition pending."

Respondent disagrees. These are not related cases, save they all involve patents. Each other case is concerned solely with the question of obviousness in view of the prior art, under 35 U.S.C. 103, not here involved.

Thus, in *Graham v. John Deere Co.*, No. 580, certiorari granted, the question is the validity of a patent on a clamp for a plow in view of *the prior art*; in *Calmar, Inc. v. Cook Chemical Co.*, No. 778, petition pending, the question is whether a patent on a pump spray device was properly held valid over the *prior art*, and infringed; in *United States v. Bert N. Adams*, No. 906, petition pending, the question is whether a patent on a battery is valid over the *prior art*.

The above cases all involve questions once termed "invention" over prior art, inventive level, or the so-called "standard of patentability", i.e., what are now 35 U.S.C. 103 questions. But the instant case has nothing to do with any 35 U.S.C. 103 question and is not part of any "larger context of related patent problems". It is truly *sui generis*.

5. THE DECISION BELOW WAS CORRECT

The majority of the court below was properly concerned only with the usefulness of the invention claimed, rather than the usefulness of something else not the invention. The invention claimed in Claim 2 of respondent's application is

"A process for preparing 2 alpha, 17 alpha-dimethylandrostan-17 beta-ol-3-one comprising hydrogenating 2-hydroxymethylene-17 alpha-methylandrostan-17 beta-ol-3-one in the presence of a palladium catalyst." (R-81)

The invention of Claim 2 works to do what it is supposed to do. Whatever works successfully benefits the public. Respondent's claimed process represents an alternative way to make the 2-alpha compound. It takes nothing the public had before, but adds another tool to the public's storehouse of technology.

An analogy will point up the absurd result of petitioner's contention that Manson's new process for producing a known compound is useless. If the invention claimed were a process for printing books, petitioner would say the process was useless and unpatentable unless the particular book printed by the inventor was a "useful" book; merely using the new process to print any known book would not suffice; and, maybe petitioner would even require the inventor of the new printing process to write the book. Application of the principle involved in the decision below to other processes points up its correctness.

CONCLUSION

It is submitted there should be a limited grant of the petition for certiorari solely to the jurisdictional question whether decisions of the Court of Customs and Patent Appeals in patent cases are reviewable on certiorari, which was left open in *Glidden Company v. Zdanok*, 370 U.S. 530, 578, n. 49, so this court can determine whether the broad position of petitioner or the narrower one of respondent on this question is correct.

In so far as any part of the petition is concerned with the merits of the decision below, it should be denied for the reasons given.

Respectfully submitted,

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March 1965

1. The first part of the document is a letter from the President of the United States to the Congress, dated January 3, 1801. It contains a statement of the President's views on the state of the Union and the progress of the government.

2. The second part of the document is a report from the Secretary of the Treasury, dated January 10, 1801. It contains a statement of the financial condition of the United States and the progress of the Treasury Department.

3. The third part of the document is a report from the Secretary of the Navy, dated January 15, 1801. It contains a statement of the naval condition of the United States and the progress of the Navy Department.

4. The fourth part of the document is a report from the Secretary of the War, dated January 20, 1801. It contains a statement of the military condition of the United States and the progress of the War Department.

5. The fifth part of the document is a report from the Secretary of the Interior, dated January 25, 1801. It contains a statement of the internal condition of the United States and the progress of the Interior Department.

APPENDIX TO RESPONDENT'S BRIEF

35 U.S.C. 6, "Duties of Commissioner [of Patents]" provides in pertinent part:

"The Commissioner, . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

35 U.S.C. 103. "Conditions for patentability; non-obvious subject matter" reads:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U.S.C. 134, "Appeal to the Board of Appeals" reads:

"An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

35 U.S.C. 135, "Interferences" provides in pertinent part:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with . . . any unexpired patent, he shall give notice thereof to the . . . applicant and patentee The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." . . .

35 U.S.C. 141, "Appeal to Court of Customs and Patent Appeals" provides in pertinent part:

"An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, . . ." . . .

35 U.S.C. 144, "Decision on Appeal" reads:

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

Rule 204(b) of the Rules of Practice of the United States Patent Office Cases, [37 C.F.R. Section 1.204(b)] as it read at the time the instant case arose and until January 1, 1965:

"204. Interference with a patent; affidavit by junior applicant * * *

"(b) When the filing date or effective filing date of an applicant is subsequent to the filing date of a patentee, the applicant, before an interference will be declared, shall file an affidavit that he made the invention in controversy in this country, before the filing date of the patentee, or that his acts in this country with respect to the invention were sufficient under the law to establish priority of invention relative to the filing date of the patentee; and, when required, the applicant shall file an affidavit (of the nature specified in rule 131) setting forth facts which would prima facie entitle him to an award of priority relative to the filing date of the patentee."

Amended Rule 204(b) and (c). By notice published in 29 F.R. 15 866, 15 867, November 26, 1964, Patent Rule 204 was amended, the amended rules to take effect January 1,

1965 and apply to interferences proposed for declaration after that date. The notice read:

"Section 1.20(b) of Title 37 C.F.R. (Patent Rule 204) is amended and new paragraph (c) is added, as follows:

1.204. Interference with a patent; affidavit by junior party.

- (b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the interference will be declared, shall file an affidavit that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective date of the patentee.
- (c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits by himself and by one or more corroborating witnesses, supported by documentary evidence if available, setting out a factual description of acts and circumstances which would *prima facie* entitle him to an award of priority relative to the effective filing date of the patentee, and accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the effective filing date of the patentee. Upon a showing of sufficient cause, an affidavit on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patentee may be accepted in lieu of an affidavit by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patentee is alleged, and if so, the interference will be declared."

Rule 131 of the Rules of Practice of the United States Patent Office in Patent Cases [37 C.R.F. Section 1.131] reads:

131. Affidavit of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained."

